182 (3)

No. 10-862

IN THE

Supreme Court of the United States

GREGORY W. BARAN, M.D.,

Petitioner,

v.

MEDICAL DEVICE TECHNOLOGIES, INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

REPLY BRIEF FOR PETITIONER

STEVEN M. AUVIL
Counsel of Record
BRYAN A. SCHWARTZ
BRYAN J. JAKETIC
BENESCH FRIEDLANDER COPLAN & ARONOFF, LLP
200 Public Square, Suite 2300
Cleveland, Ohio 44114-2378
(216) 363-4686
sauvil@beneschlaw.com

234751

COUNSEL PRESS
(800) 274-3321 • (800) 359-6859

TABLE OF CONTENTS

	Page
TABLE OF CONTENTS	i
TABLE OF CITED AUTHORITIES	ii
REPLY BRIEF FOR PETITIONER	1
ARGUMENT	1
CONCLUSION	7

TABLE OF CITED AUTHORITIES

Page

CASES

Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.,
296 F.3d 1106 (Fed. Cir. 2002) 2, 4

Generation II Orthotics, Inc. v. Med. Tech., Inc.,
263 F.3d 1356 (Fed. Cir. 2001) 4, 5, 6

Halliburton Oil Well Cementing Co. v. Walker,
329 U.S. 1 (1946) 1, 5

Markman v. Westview Instruments, Inc.,
517 U.S. 370 (1996) 6, 7

Micro Chem. Inc. v.
Great Plains Chem. Co., Inc.,
194 F.3d 1250 (Fed. Cir. 1999) 2, 4, 5

Providence Rubber Co. v. Goodyear,
76 U.S. (9 Wall.) 788 (1869) 2

Warner-Jenkinson Co., Inc. v.
Hilton Davis Chemical Co.,
520 U.S. 17 (1997) 3

STATUTES

35 U.S.C. § 112 (2010) ..... *passim*

Page

OTHER AUTHORITIES

Applera Corp. v. Enzo Biochem, Inc.,
No. 10-426 (cert. petition docketed
Sept. 28, 2010) 7

REPLY BRIEF FOR PETITIONER

This case concerns a provision of the Patent Act (35 U.S.C. § 112, ¶ 6) that was enacted in response to this Court's decision in *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1 (1946) to permit inventors to claim an element of an invention "as a ***means . . . for performing a specified function***" without reciting in the claim itself the particular structure of that element. Yet, even though Petitioner's patent expresses an important element of his needle biopsy invention exactly in the sanctioned format, the courts below rewrote the element to include a function not specified by the means clause.[1] The result was an improperly narrowed claim and an unjustified finding of non-infringement. Unless this Court intervenes, the decision puts all patents containing claim elements written in the sanctioned "means-plus-function" format of § 112, ¶ 6 at risk of being similarly narrowed under the guise of court-imposed claim construction.

ARGUMENT

Respondent does not deny that the question presented by the Petition is a novel question of federal law that has not been settled by this Court. Nor does Respondent contest that the question presented is squarely raised by the decision below or that it is a question whose answer

---

1. The claim element as **written** is: "a release means *for retaining* the guide member in the charged position." (The guide member guides the cutting element of the needle (cannula) forwards and backwards.) The claim element as **rewritten** by the courts below is: "[a means for] retaining the guide in the charged position *and releasing, or setting free,* the guide from the charged position." Pet. App. F 150a (emphasis added).

potentially affects countless issued patents and pending applications. Instead, Respondent's brief focuses on the merits of Petitioner's views of the statute and the Federal Circuit's departure from its text. While misdirected, these arguments are easily refuted.

First, Petitioner does not, as Respondent contends, seek to impose a "rigid rule of required syntax" on functional patent claiming. Nor could he. Section 112, ¶ 6 is clearly permissive, and not all functional claims follow its guidance. However, Petitioner asks the Court to decide whether the statute requires that when an inventor ***does elect*** to claim an element of an invention "as a *means . . . for* performing a *specified function*" (§ 112, ¶ 6), the inventor's specified function must be honored and not "interpolate[d]" to include that "which it does not contain." *Providence Rubber Co. v. Goodyear*, 76 U.S. (9 Wall.) 788, 795 (1869). To the extent Respondent uses "syntax" as a euphemism for the specific format that Congress authorized, then Petitioner pleads guilty to requesting a rigid rule in conformance with the language Congress enacted into law.[2]

Moreover, the need for this Court's interpretation of the statutory requirement is heightened because following the statute's direction has real consequences for the

2. While Respondent contends that "the location of words" is unimportant (Opp. 7), the Federal Circuit has previously instructed the district courts that "the properly identified function" of a claim in "means-for" format is "signaled by the preposition 'for[.]'" *Micro Chem. Inc. v. Great Plains Chem. Co., Inc.*, 194 F.3d 1250, 1258 (Fed. Cir. 1999). *See also Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1114-15 (Fed. Cir. 2002) (two uses of preposition "for" following the word "means" in the same means clause signaled two, separate functions).

inventor who chooses to do so. As the Petition pointed out, but Respondent ignores, § 112, ¶ 6 strikes a bargain with the inventor that claim elements written according to it are restricted in their coverage to structures actually disclosed in the specification (and their equivalents). Pet. 10 n.2 (citing authority). Stated another way, such claim elements are subject to "the **proviso** that application of the[ir] broad literal language . . . must be limited to only those means that are 'equivalen[t]' to the **actual means shown** in the patent specification." *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 28 (1997) (emphasis added). Thus, writing claim elements according to the direction provided in § 112, ¶ 6 brings with it a significant restriction on claim coverage, a tradeoff that does not apply to non-functional claiming.

The potential impact to an inventor of this tradeoff is well illustrated in the case at bar. The courts' finding that the disputed means-plus-function element included a releasing function, in addition to the specified retaining function, meant that the claim's coverage was limited to only those structures actually shown in the patent (or equivalents) as performing the two functions. Although the courts held that Respondent's biopsy device performed both functions, they concluded that Respondent's device did not infringe the claim because the structure performing the releasing function was "flexible," whereas the patent specification was found to describe a "rigid" structure. Pet. App. C 20a. While it was disappointing to Petitioner that the courts enabled Respondent to escape infringement on this unexpected ground, the case has broader implications. Lower courts and accused infringers will undoubtedly latch onto this ruling as a legal basis for further narrowing the scope of claims drafted according to § 112, ¶ 6, claims that are already restricted by operation

of the statutory "proviso" limiting their coverage to equivalents of structures actually shown in the patent.

Second, Respondent's argument that this case does not break from precedent is also misguided. In two cases directly on point, the Federal Circuit held it "impermissible" to construe the function of an element drafted in "means-plus-function" form to include functions not specified in the means clause, finding instead that the function for each element was neither more nor less than the exact language in the means clause that followed the preposition "for." *Micro Chem. Inc. v. Great Plains Chem. Co., Inc.*, 194 F.3d 1250, 1258 (Fed. Cir. 1999); *Generation II Orthotics, Inc. v. Med. Tech., Inc.*, 263 F.3d 1356, 1363 (Fed. Cir. 2001). It is a distinction without a difference that the offending district courts in these cases erred by poaching language directly from the specification to improperly modify the stated functions, whereas the courts here relied on a prefatory claim term as the basis for rewriting the specified function to conform to what the specification purportedly shows the inventor "contemplated." Pet. App. C 19a. The ultimate result is still a clear break from the formerly settled proposition that the function of an element written in "means-plus function" format is that function (or functions) expressly specified in the means clause.[3]

---

3. Contrary to Respondent's argument (Opp. 8 n.2), Petitioner does not dispute that a "means-plus-function" claim element *may* state more than one function. However, in the case cited by Respondent, the court based its conclusion that there were two recited functions on the fact that the means-plus-function clause at issue used the preposition "for" twice after the word "means," which the court found to signal that the inventor had claimed two, separate functions. *Cardiac Pacemakers*, 296 F.3d at 1114-15. That is not the case here.

Finally, Respondent argues that Petitioner advocates an interpretation of § 112, ¶ 6 that would create more problems than it solves by "curbing" the flexibility of inventors in drafting functional claims, by mandating "unintended interpretations" of those prefatory words commonly employed to introduce means-plus-function claims, and by requiring courts to ignore words in claims. Opp. 9-10. None of these points is remotely valid.

First, Respondent's argument regarding lost drafting flexibility is untenable. No flexibility is lost by strictly interpreting the statute, because § 112, ¶ 6 is permissive. As noted above, patentees are not required to conform to the statutory format in order to claim their inventions functionally; rather, the statute provides a mechanism by which purely functional claims (without recitation of structure) "*may* be expressed" if an inventor so chooses. Petitioner's position is that when an inventor so chooses, his expression should be honored.

Second, it is the decision below, not Petitioner's proposed interpretation, that creates confusion over the use of prefatory words in claims drafted according to the statute. Indeed, until this case, it was clear that this drafting convention had no impact on the recited function of a such a claim. Respondent cites no case in which such a prefatory term was construed to be part of the function of a claim element drafted in means-plus-function format.[4]

---

4. Respondent does not deny that the drafting style using prefatory words as introduction to a means clause is ubiquitous or that it was used in the claims at issue in *Generation II* and *Micro Chem.* (and even *Halliburton* itself) without any suggestion that such a usage could alter the recited function of the claim. *See* Pet. 14.

Third, the interpretation of the statute advocated by Petitioner would not require the courts to ignore words. Properly instructed by this Court that the statute *does not permit* interpolating functions into claim elements drafted in "means-plus-function" format, courts will be constrained to find plausible interpretations for terms not included in a means clause that do not dishonor the function specified by inventors who chose to use the "means for" format in their claims.

To be sure, this last point may strike some as derogating from the authority that this Court's seminal decision in *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996) gave the courts over the interpretation of patent claims. But, while *Markman* placed extensive claim interpretation authority in the courts, it did not suggest that the courts could, under the guise of exercising that authority, override an act of Congress such as § 112, ¶ 6 that sanctions a particular form of patent claiming. Previously, it appeared that the courts understood that their *Markman* authority was restricted in the context of this unique statutory provision. *See Generation II*, 263 F.3d at 1364 (rejecting analogy to cases construing functional words in *non-* § 112, ¶ 6 claims as "lack[ing] merit" because "we are construing the functional statement in a means-plus-function limitation."). While the *Markman* genie is long out of the bottle, this Court should provide direction to the courts below concerning the constraints on their claim interpretation role when confronted with claims drafted according to the mandate Congress provided in § 112, ¶ 6.[5]

---

5. Petitioner notes that certiorari has been requested on the proper interpretation of a different paragraph of § 112 (paragraph

CONCLUSION

The plain language of 35 U.S.C. § 112, ¶ 6 provides inventors with a framework for claiming elements of their inventions in functional language without the need to recite structure, so long as they specify what that claimed function is. Although the Petitioner elected to use the sanctioned framework, the courts below paid that election no deference, determining that the proper construction of the disputed claim element included an additional function that he did not specify.

Petitioner submits that the authority to interpret patent claims that this Court bestowed on the courts under *Markman* is and must be constrained where an act of Congress permits a specific form of expression for patent claims and mandates a restricted coverage for claims written according to that form, as § 112, ¶ 6 does. Resolving the question presented by the Petition—**does 35 U.S.C. § 112, ¶ 6 permit adoption of a function other than that specified in the "means for" clause or not?**—will provide needed guidance to the lower courts, litigants, patent holders, and patent applicants on this important and unique provision of the patent laws.

* * * *

---

2) in *Applera Corp. v. Enzo Biochem, Inc.*, No. 10-426 (cert. petition docketed Sept. 28, 2010). That case is related only to the extent that the petition also seeks this Court's interpretation of § 112 and a determination that the Federal Circuit has veered from the text of the statute.

For the foregoing reasons and those stated in the Petition, the petition for writ of certiorari should be granted.

Respectfully submitted,

STEVEN M. AUVIL
Counsel of Record
BRYAN A. SCHWARTZ
BRYAN J. JAKETIC
BENESCH FRIEDLANDER COPLAN & ARONOFF, LLP
200 Public Square, Suite 2300
Cleveland, Ohio 44114-2378
(216) 363-4686
sauvil@beneschlaw.com